

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:)	
Brian Leslie Smalley, et al.)	Confirmation No.: 4424
)	
Serial No.: 10/523,887)	Art Unit: 3651
)	
Filed: September 6, 2005)	Examiner: Michael Collins
)	
For: DISPENSING PACKAGE)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is filed pursuant to 37 CFR 41.41, in response to the Examiner's Answer dated October 18, 2010 ("Examiner's Answer").

The appealed claims stand finally rejected on the following grounds:

- (1) Claims 1, 6, 9, 60-66, 70-73, 75 and 76, anticipated by Hoy et al., U.S. Pat. 5,878,947 (*Hoy*), under 35 U.S.C. § 102(b).
- (2) Claims 2 and 4, unpatentable over *Hoy*, under 35 U.S.C. § 103(a).

For the reasons discussed in the Appeal Brief filed on July 15, 2010 ("the Appeal Brief"), Applicants contend that these rejections are not well taken, and request that the final rejection be reversed. In addition, the Board is requested also to consider the following remarks, which are submitted in response to assertions and arguments presented in the Examiner's Answer.

(1) Claims 1, 6, 9, 60-66, 70-73, 75 and 76 are not anticipated by *Hoy*

Independent claims 1 and 64 recite a "first portion" that is "removable from the carton along the first tear line to create a first opening for article removal," with the Examiner

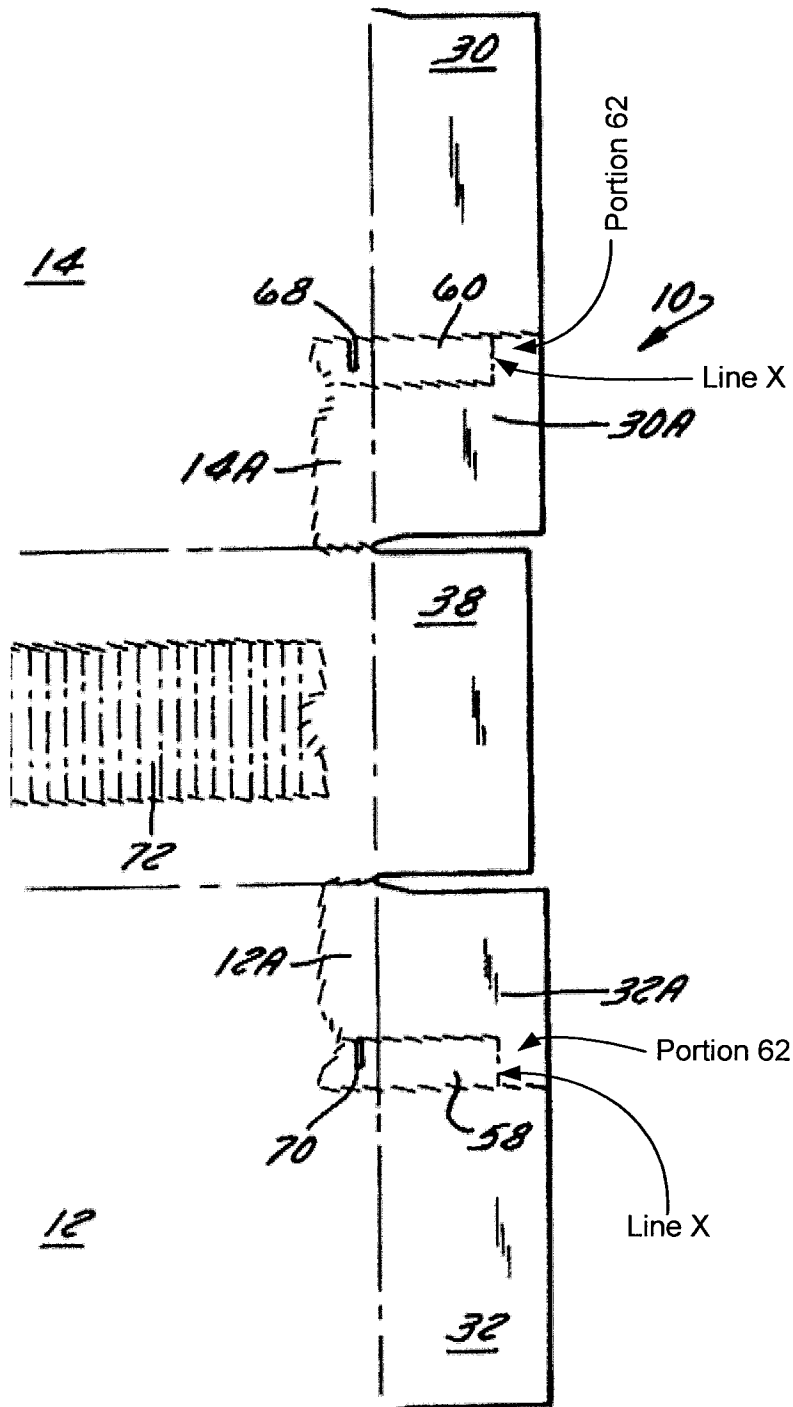
referencing the claimed first portion on strips 58, 60, and flap 62 of *Hoy* (Examiner's Answer, pp. 4 and 6). Applicants submit that the claim language cannot be so read.

Hoy discloses a carton for cans in which a dispenser tray 50 can be formed by tearing away portions 12A, 14A of the side panels and a portion 30A, 32A of the end closure flaps (Figs. 5 and 6), and then folding the portions 12A, 14A, 30A, and 32A down as shown in Fig. 7. Strips 58, 60, which are located at the upper ends of portions 12A, 32A and 14A, 30A, are torn partially back as far as flap 62 and then folded outwardly and interlocked at slots 68, 70 to form a stop 56 (see col. 3, lines 14-19, and Fig. 7).

Although the strip formed by 58, 60, and 62 of *Hoy* is not removed from the carton as claimed, the Examiner takes the position that "Figure 6 of the reference discloses a strip bounded by lines of perforation which enable a portion to be removed", and "the lines of perforation in combination with the material [paperboard] provides a disclosure which enables a first portion to be removed" (Examiner's Answer, p. 10). Applicants respectfully disagree. *Hoy* does not disclose that the entire strip 58, 60, 62 is "bounded by lines of perforation" as claimed, but rather shows on one side of portion 62 of the strip that a line of perforation is not provided.

Shown below, in part, is *Hoy*'s Fig. 4 (the blank from which the *Hoy* carton is formed), which has been annotated for ease of discussion. Annotated Fig. 4 shows that the tear lines between strip 58 and flap 32, and between strip 60 and flap 30, extend all the way to the outer edges of flaps 30, 32. However, the tear lines between strip 58 and portion 32A, and between strip 60 and portion 30A, do not extend to the outer edges of flaps 30, 32, but instead extend only as far as portion 62, i.e., to "Line X". There is no line of any kind separating the portions 62 from portions 30A and 32A, respectively. This arrangement of tear lines is consistent with the operation of the *Hoy* carton, in which, as described above, strip 58, 60 remains attached to the

tray 50 at portion (flap) 62, and portions 58, 60 are folded outward relative to portion 62 to form stop 56 (see FIGs. 2 and 7 of *Hoy*). Also consistent with *Hoy*'s operation is the fact that the lines (both "Line X" segments) separating portion 62 from portions 58 and 60 are depicted differently than the tear lines, and appear to be fold lines, not tear lines.



The Examiner's position appears to be, in essence, that the strip 58, 60 of *Hoy* would be inherently removable from the carton along portion 62 because it is bounded (i.e., surrounded) by perforated lines, a conclusion which the Examiner draws from *Hoy* Fig. 6. However, this is simply an assumption on the Examiner's part; an assumption that is not supported by *Hoy*. In fact, to support the rejection, *Hoy* would have to show that portion 62 is bounded by tear lines from Line X to the periphery of end flaps 30A and 32A. As discussed above, *Hoy* does not show such tear line arrangement, and, as Applicants averred in the Appeal Brief, *Hoy* cannot be so modified to permit removal of portion 62 without destroying the intended functionality of the carton (i.e., to retain cans from rolling out of the carton once opened). *Hoy*'s Annotated Fig. 4, *supra*, shows that portion 62 is not separated from parts 30A, 32A by any line (of perforations or otherwise), and, consistent with the operation of the *Hoy* carton, portion 62 would not be separated from 30A, 32A by a line of perforations (i.e., a tear line) because it must remain attached to tray 50 in order to form stop 56.

To the extent that *Hoy*'s Fig. 6 might be interpreted as showing a line of perforation between portion 62 and parts 30, 32 below it, i.e., between portion 62 and the remainder of tray 50, such interpretation is inconsistent both with Fig. 4, which shows no such line, and with the method of operation of the *Hoy* carton. This inconsistency creates an ambiguity which precludes anticipation of the appealed claims by *Hoy*, for, as held in In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962), "[i]t is well established that an anticipation rejection cannot be predicated on an ambiguous reference." Moreover, "[i]nherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." Trinitec Industries, inc. v. Top-USA Corp., 295 F.3d 1292, 1295, 63 USPQ2d

1597, 1599 (Fed. Cir. 2002). In the present case, as discussed above, strip 58, 60 of *Hoy* is not necessarily entirely bounded by perforations so as to be inherently removable from the carton.

Apparently as an alternative position to the assumption discussed above, the Examiner further asserts that:

the stop (56) does not need to be completely removed in order to anticipate the claims because Appellant does not claim removal in such a way that requires actual separation from the carton. (Examiner's Answer, p.12)¹

This position appears to be based on the Examiner's interpretation of the term "removable", as follows:

With regard to a broad and reasonable reading of "the first portion being removable from the carton" it should also be noted that Webster's II Dictionary (Third Ed. 2005.) defines remove as "To move from a position occupied" and removable as "The act of removing." As shown in Figure 2 strips (58,60) are removed (as in their previously occupied position) from the carton of Figure 1 in order to make the stop (56) and new carton of Figure 2. (Answer, pp. 10-11)

The Examiner's assertion that the strips 58, 60 of *Hoy* are "removable" is incorrect. It is well settled that "[w]hen examining claims for patentability, claims are interpreted as broadly as reasonable and consistent with the specification". In re Thrift, 298 F.3d 1357, 1364, 63 USPQ2d 2002, 2006 (Fed. Cir. 2002)(emphasis added). The Examiner here has violated this basic rule by giving the term "removable" a meaning inconsistent with Applicants' specification. In Applicants' carton, a portion 33 is removed from the carton to leave an opening (see Fig. 8) through which articles 31 can be removed from the carton. As stated on p. 3, lines 24-25, "A small portion 28 of the side panel 15 is intended to remain after the removable portion 33 has been removed thereby to act as a stop wall." (emphasis added) Also, on p. 4, lines 23-25, "[t]he removable portion is then removed so as to enable consumers to remove the cans 31 through the resulting roll-out dispensing aperture as shown in Fig. 8." (emphasis added) Thus it is clear that

¹ Although this statement is made in the analysis of the §103(a) rejection of claims 2 and 4, it appears to be applicable to the §102(b) rejection, since the Examiner refers to anticipation.

“remove” is used in the specification in the sense of “elimination” or “taking out”, with the removable portion 33 being taken off the carton, rather than remaining attached to the carton.

Merriam-Webster’s Collegiate Dictionary (11th Ed. 2004) provides a number of definitions for the word “remove”, i.e.:

re-move \ri-ˈmüv\ *vb* **re-moved**; **re-mov-ing** [ME *remeven*, *removen*, fr. AF *remuver*, *removeir*, fr. L *removēre*, fr. *re-* + *movēre* to move] *vt* (14c) **1 a** : to change the location, position, station, or residence of <~ soldiers to the front> **b** : to transfer (a legal proceeding) from one court to another **2** : to move by lifting, pushing aside, or taking away or off <~ your hat> **3** : to dismiss from office **4** : to get rid of : ELIMINATE <~ a tumor surgically> ~ *vt* **1** : to change location, station, or residence <*removing* from the city to the suburbs> **2** : to go away **3** : to be capable of being removed — **re-mov-abil-i-ty** \-,mü-və-ˈbi-lə-tē\ *n* — **re-mov-able** *also* **re-move-able** \ri-ˈmü-və-bəl\ *adj* — **re-mov-able-ness** \-,mü-və-bəl-nəs\ *n* — **re-mov-ably** \-blē\ *adv* — **re-mov-er** *n*

The definition selected by the Examiner is not an interpretation which is consistent with Applicants’ specification.² More consistent would be definition no. 4, “to get rid of”. It is evident that the strip 58, 60 of *Hoy* does not meet this definition, since it is not gotten rid of by taking it away from the carton, but instead remains attached to the carton. By contrast, claims 1 and 64 recite that the first portion is removable “from the carton”. Applicants submit that one of ordinary skill in the art, reading the claims in light of Applicants’ disclosure, would not consider that tearing *Hoy*’s strips 58, 60 back to flap 62 would constitute “removal” of the strips from the carton, since the strips remain attached to the carton to form stop 56 on tray 50.

Further still, the Examiner’s statement (quoted above) that strips 58, 60 (of *Hoy*) “are removed (as in their previously occupied position) from the carton of Figure 1 in order to make the stop (56) and new carton of Figure 2” is not entirely understood. Strips 58, 60 are not removed from the carton, and tearing the tear lines of *Hoy*’s Fig. 1 then opening up the tray 50 to

² As stated in *Liebscher v. Boothroyd*, 258 F.2d 948, 951, 119 USPQ 133, 135 (CCPA 1958), quoted in *Novartis Pharm. Corp. v. Eon Labs Mfg., Inc.*, 363 F.3d 1306, 1310, 70 USPQ2d 1438, 1441 (Fed.Cir. 2004): “One need not arbitrarily pick and choose from the various accepted definitions of a word to decide which meaning was intended as the word is used in a given claim. The subject matter, the context, etc., will more often than not lead to the correct conclusion.”

the position shown in Fig. 2 does not make a “new carton” any more than opening the door of a car makes a new car.

As a final point, it is noted that claims 1 and 64 recite that the first portion is removable from the carton “to create a first opening for article removal”. These claims also recite that the second portion is separable to create a second opening, “wherein the second opening and first opening together define an enlarged opening, the enlarged opening enabling easier article removal from the carton than the first opening”. Even if the strip 58, 60 of *Hoy* (the “first portion”) were considered removed from the carton, it would not create a first opening for removal of articles 52, as recited in claims 1 and 64. Rather, in *Hoy* the opening for removing articles is created by folding down the purported “second portion”, namely, portions 12A, 14A, 30A, 32A of tray 50, along with strip 58, 60, 62, which opening does not “enabl[e] easier article removal from the carton than the first opening” as recited in claims 1 and 64 because the first opening would not enable any article removal at all.

Therefore, because claims 1, 6, 9, 60-66, 70-73, 75 and 76 are not readable on *Hoy*, the rejection under 35 U.S.C. § 102(b) should be reversed.

(2) Claims 2 and 4 are not unpatentable over *Hoy*

These claims call for, respectively, a divider pad secured to the inside of the carton, and the divider pad having a fold down gluing panel. The Examiner provides no evidence that it would have been obvious to add these features to the *Hoy* carton, but merely states his conclusion that it would have been obvious to do so, citing In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). (Examiner’s Answer, p. 9). In re Leshin is not applicable here. Leshin related to the selection of materials and held that it would have been obvious to select a suitable, known plastic to make a container that was known as being made of plastic. In the

present case, the question is not the selection of a known material; rather, the question is whether it would have been obvious to add the claimed additional structure to the *Hoy* carton. The Examiner has not asserted any reference that teaches such a structure or that suggests such a modification of *Hoy*.

The PTO has the initial duty of supplying the factual basis for its rejection, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), and absent such a factual basis, a prima facie case of obviousness has not been established. In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, there is no rational underpinning or factual basis for the Examiner's rejection, merely his conclusion. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), quoted in KSR Int'l. Co. v. Teleflex Inc., 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007).

Accordingly, claims 2 and 4 are patentable both by virtue of their dependence on claim 1, and because the Examiner has not established a prima facie case of obviousness.

Conclusion

For the reasons stated in the Appeal Brief, supplemented by the foregoing, the appealed claims would not have been anticipated by or obvious to one of ordinary skill in the art over the reference applied by the Examiner in the final rejection. It is therefore respectfully requested that the final rejection of claims 1, 2, 4, 6, 9, 60-66, 70-73, 75 and 76 be reversed.

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,

12/13/10
Date

Keats A. Quinalty
Keats A. Quinalty
Registration No. 46,426

Customer No. 26158
WOMBLE CARLYLE SANDRIDGE & RICE
P. O. Box 7037
Atlanta, Georgia 30357-0037
(404) 879-2423 (Telephone)
(404) 879-2923 (Facsimile)

Docket No.: R031 1160.1